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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/681,948 | 06/29/2001 | Scott C. Harris | Shape | 1049 |

| | | | EXAMINER |
|---|---|---|---|
| 23844 | 7590 | 08/08/2005 | COUSO, YON JUNG |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2625 | |

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/681,948 | HARRIS, SCOTT C. |
| | Examiner | Art Unit | |
| | Yon Couso | 2625 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)☒ Responsive to communication(s) filed on _20 June 2005_.

2a)☒ This action is **FINAL**.          2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4)☒ Claim(s) _1-3 and 6-17_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-3, 6-17_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

### Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some *  c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

1.     Applicant's arguments filed June 20, 2005 have been fully considered but they are not persuasive.

a. The applicant argues that the whether process could be done by somebody is not dispositive of whether the claims are statutory under 35 USC 101. The examiner disagrees. When someone processes this method in their head, it becomes mental process and therefore becomes abstract ideas. The specification is clear that this process is carried out by a computer. Applicant may consider including the words, "computer implemented process" to overcome the rejection.

b. The applicant argues that the Matsugu does not teach anything about recognizing actual objects within the image. The applicant also states that Matsugu teaches extracting feature elements from the image, wherein the feature elements are lines and curves within the image. The applicant further argues that feature elements are not actual objects. The examiner disagrees. The Random House College Dictionary defines object as "anything that is visible or tangible and is stable in form; anything that may be apprehended intellectually; a person or thing with reference to the impression made on the mind or the feeling; a thing , person or matter to which thought or action is directed". There seemed to be no basis to conclude that the feature elements in Matsugu are not actual objects. The fact that the applicant call the feature elements in Matsugu as "L-type intersection and curve element", solidify that those feature elements are objects, actual objects.

c. The applicant argues that Matsugu teaches nothing about the claimed orientation of the recognized parts. Matsugu teaches the individual part information

includes information about size and orientation of the recognized part relative to the unit

recognized part (column 5, lines 10-19). The element 12 "extract local feature elements"

in figure 1b extracts local information such as size and orientation.

d. The applicant argues that there is not motivation to combine Matsugu and

Ferguson. The examiner disagrees. Matsugu does not teach details on updating the

database when the image portions are not found in the database. However, Matsugu

clearly discloses using the closest match between the image data and the database

data. Updating the database based on the match results or modification is old and well-

known in the art. Ferguson discloses updating the database when the image portions

are not found in the database at column 6, lines 18-30. Given the references at the time

the invention was made, it would have been obvious to one of ordinary skill in the art to

incorporate old and well-known technique of database updating system taught in

Ferguson into Matsugu because Matsugu already teaches utilizing closest match

between the image data and the database data. It would only make sense to include

updating database when the closest match does not meet the minimum threshold set by

the system to increase the reliability and overall system performance.

e. The applicant argues that even the Matsugu and Ferguson are combined,

there is nothing or suggestion to store the list of image portion which are not found in

the database. The examiner disagrees. Ferguson discloses updating the database

when the image portions are not found in the database at column 6, lines 18-30. Given

the references at the time the invention was made, it would have been obvious to one of

ordinary skill in the art to incorporate old and well-known technique of database

updating system taught in Ferguson into Matsugu because Matsugu already teaches

utilizing closest match between the image data and the database data. It would only

make sense to include updating database when the closest match does not meet the

minimum threshold set by the system to increase the reliability and overall system

performance.

2.      35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine,
> manufacture, or composition of matter, or any new and useful improvement
> thereof, may obtain a patent therefor, subject to the conditions and requirements
> of this title.

Claims 1-3, 6-8 and 14-17 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

The claims are directed to somebody analyzing a picture and labeling the picture

part would read on the claim. For instance, a child putting the word "apple" on top of a

picture of an apple and the word "car" on top of a picture of a car.

Also see above paragraph 1a.

3.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under
> section 122(b), by another filed in the United States before the invention by the
> applicant for patent or (2) a patent granted on an application for patent by
> another filed in the United States before the invention by the applicant for patent,
> except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application
> filed in the United States only if the international application designated the
> United States and was published under Article 21(2) of such treaty in the English
> language.

Claims 1-3, 6 and 8-13 are rejected under 35 U.S.C. 102(e) as being anticipated

by Matsugu et al (US Patent No. 6,463,176).

The arguments advanced in paragraph 1above as to the applicability of the

reference are incorporated herein.

As per claim 1, Matsugu teaches a method comprising: analyzing an image to

recognize parts within the image (column 4, lines 31-43); and replacing recognized

parts within the image by an indication representing the recognized part (column 6, lines

36-44). Matsugu teaches the recognized part includes information about the actual

object represented by the part in the image (31 in figure 3).

As per claim 2, Matsugu teaches the replacing includes providing individual part

information indicative of how the recognized part within the image differs from a unit

recognized part (column 5, lines 31-36).

As per claim 3, Matsugu teaches the individual part information includes

information about size and orientation of the recognized part relative to the unit

recognized part (column 5, lines 10-19).

As per claim 6, Matsugu teaches obtaining information about subparts of the

actual object (32 in figure 3).

As per claim 8, obtaining information from the actual object about other objects

which may exist in the image (column 2, line 57-column 3, line 28).

As per claim 9, Matsugu teaches an image analyzing device, comprising: an

image obtaining device, obtaining a n electronic file indicative of an image (A1 and A7 in

figure 1A); a database, storing a plurality of image parts representing likely parts which

may exist in the image (A10 in figure 1A); and an image processing device, processing

the electronic file to recognize parts within the electronic file that correspond to the

image parts in the database (A8 in figure 1A and column 4, lines 34-43), and to provide

a modified electronic file, indicative of the image, which replaces the recognized parts

with indications representing the recognized parts based on information in the database

(column 6, lines 36-44). Matsugu teaches the recognized part includes information

about the actual object represented by the part in the image (31 in figure 3).

As per claim 10, Matsugu teaches producing additional information that

represents how a recognized part within the image differs from a part within the

database (column 5, lines 31-36).

As per claim 11, Matsugu teaches information about differences in size and

orientation of the recognized part (column 5, lines 16-19).

As per claim 12, Matsugu teaches recognizing actual objects in the image, and

finds image parts in the database, which correspond to the actual object (column 5,

lines 7-65).

As per claim 13, Matsugu teaches that the database also stores information

indicative of other objects in the image which may appear near the actual objects, and

wherein the image processing device processes the electronic file to look for the other

object (column 5, lines 7-65).

4.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the

subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsugu et al in view of Ferguson et al (US Patent No. 6,810,404)

The arguments advanced in paragraph 3 above as to the applicability of the reference are incorporated herein.

As per claim 14, Matsugu teaches a method comprising: analyzing an image against a database, to find portions of the image which are present in the database, and to replace the portions of the image which are present in the database with information based on the image in the database (column 4, lines 31-43 and column 6, lines 36-44). Matsugu does not teach details on updating the database when the image portions are not found in the database, but teaches using the closest match between the image data and the database data. Updating the database based on the match results or modification is old and well-known in the art. Ferguson discloses this at column 6, lines 18-30. It would have been obvious to one of ordinary skill in the art to incorporate old and well-known technique of database updating system into Matsugu, which utilizes closest match system. It would only make sense to include updating database when the closest match does not meet the minimum threshold set by the system.

As per claim 15, Matsugu teaches sending the list of image portions to a database developer (column 6, lines 18-30).

As per claim 16, Matsugu teaches analyzing comprising compressing the image using information in the database (column 6, lines 27-31).

As per claim 17, Ferguson teaches obtaining updates to the database to the database from the database developer (column 6, lines 18-30).

As per claim 7, Ferguson teaches text information (figure 2A).

5.      **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6.      Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yon Couso whose telephone number is (571) 272-7448. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.
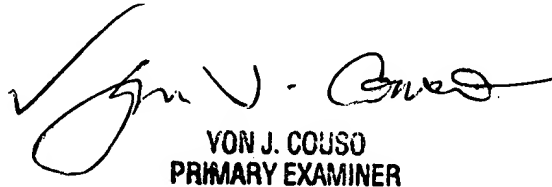
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta, can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

YJC

VON J. COUSO
PRIMARY EXAMINER

August 1, 2005